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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,144	01/11/2002	Ken Wilson	RENI-F80	3967
22848	7590	05/25/2006	EXAMINER	
STEINS & ASSOCIATES 2333 CAMINO DEL RIO SOUTH SUITE 120 SAN DIEGO, CA 92108			VANAMAN, FRANK BENNETT	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/044,144

Applicant(s)

WILSON ET AL.

Examiner

Frank Vanaman

Art Unit

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Status of Application**

1. Applicant's amendment, filed Dec. 23, 2005, in combination with the supplemental papers filed Mar. 14, 2006 has been entered in the application.

### **Litigation**

2. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patents No. 6,273,440 and/or 6,203,037 is or was (are or were) involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

### **Amendment Papers**

3. Applicant is reminded of the content of 37 CFR 1.173(c)  
(c) Status of claims and support for claim changes. Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

Applicant is reminded that certain formal requirements associated with prosecution of a reissue application vary from those of a non-reissue utility application, and care should be taken to ensure that the formal requirements associated with reissue application prosecution are observed.

### **Claim Objections**

4. Claim 1 is objected to because of the following informalities: in claim 1, lines 7-10, in each of three instances "one said closed cavity forming members" is grammatically informal. In the instant context, it appears as though the recitation should

be - -one of said closed cavity forming members- - (compare to line 6). Appropriate correction is required.

### **Claim Rejections - 35 USC § 103**

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-3 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks et al. (US 5,513,865) in view of Mayr (US 5,249,819). Brooks et al. teach a skateboard having a board portion (14) which may be made from aluminum (col. 4, line 67), and which includes a front end, rear end, and sides, and which may accommodate a user's feet in a side-to-side position (i.e., a standard skate-board riding configuration), including front and rear ends having an arcuate shape, the front and rear ends being both turned upwardly, the board further provided with truck and wheel assemblies (10). The reference to Brooks et al. fails to specifically teach that the aluminum has been extruded, however extrusion is very old and very well known for the production of stock materials having indeterminate lengths, and being of finite width and height, and it would have been obvious to use an extruded aluminum to make the board of Brooks et al. for the purpose of employing an inexpensively available material. The reference to Brooks et al. fails to teach the provision of cavities at least one of which having a height and width, wherein the width is greater than the height. Mayr teaches a gliding board construction including a plurality of cavity elements (see, e.g., figures 2-7) which may have a width which is greater than a height thereof (note figure 6), wherein the cavity sections are taught to allow control of torsional stiffness (see col. 1, lines 41-46 and 54-56), and wherein further the cavity sections may be made of an extruded material (col. 2, lines 16-21), and further wherein respective cavity closing members may be positioned adjacent respective left and right edges (e.g., outermost elements 26 or 30, figure 6b or figure 7b) and at least a further cavity closing member may be positioned along a longitudinal axis (e.g., center, 6a, 6b, 6c, 7a, 7b, etc.). It would have been obvious to one of ordinary skill in the art to provide the board of Brooks et al. with at least one cavity as taught by Mayr in the board profile, for the purpose of reducing the

overall board weight while retaining a substantial degree of torsional stiffness, thus allowing a lightweight but strong board structure.

As regards claims 8 and 9, the references fail to provide specific force-to-deflection characteristics, however it is very well known to adjust cross sections of elements to obtain different stress-strain characteristics, and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to select the material characteristics, for example thickness, of the board, such that deflection is limited under particular loadings, for the purpose of tuning the board by stiffening it.

7. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks et al. in view of Mayr and Joyce (US 3,374,495). The references to Brooks et al. and Mayr are discussed above and fail to teach the provision of plastic end guards at the front and rear ends of the board. Joyce teaches a plastic end guard (11) that may be attached to arcuate ends (10, 22) of a gliding vehicle. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide end guards at each end of the board of Brooks et al. as modified by Mayr, for the purpose of protecting the board from minor collisions with other objects.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks et al. in view of Mayr and Schorr (US 4,196,916). The references to Brooks et al. and Mayr are discussed above and fail to teach the board as having a concave profile. Schorr teaches a skateboard which may be made from a metal, and which has an upwardly concave profile (figures 2-5). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the board of Brooks et al. as modified by Mayr with an upwardly concave cross section as taught by Schorr for the purpose of allowing a rider's feet to be parallel to the riding surface, even while turning (see Schorr, col. 2, lines 56-63).

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks et al. in view of Mayr and Le Masson et al. (US 5,248,160). The references to Brooks et al. and Mayr are discussed above and fail to teach at least one cavity filled with a filler. Le Masson et al. teach a sports board having at least one continuous longitudinal cavity which is filled with a plastic foam material (31, see col. 2, line 67

through col. 3, line 2.). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide at least one of the cavities of the board of Brooks et al. as modified by Mayr with a filler in the form of a plastic foam as taught by LeMasson et al., for the purpose of damping vibrations in the board, providing a more even ride.

#### **Allowable Subject Matter**

10. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **Response to Comments**

11. Applicant's comments, filed with the amendment, have been carefully considered. Applicant's comment asserting a belief that the amendment is not necessary (page 5) is noted, however in view of applicant's having made an amendment, such a comment is not clear, and as such clouds the record. Applicant's comment directed to the Mayr reference "...was cited ... in unsuccessfully preventing the patenting of the parent application..." is noted, and the examiner further notes that such a comment is, at best, an incomplete description of the prosecution of the parent application. Applicant's comments concerning the material as not just "an extruded aluminum" and the further remarks which appear to possibly assert other non-recited limitations are noted, however it appears as though applicant is advocating the reading of unclaimed limitations into the claims.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

#### **As regards reading unclaimed limitations from the specification into the claims**

From MPEP 2111:

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified.

In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

Applicant may additionally desire to note that the limitation of the material being extruded may itself constitute a product by process form of limitation:

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)

Applicant's assertion concerning the cost of using an extruded material (page 6 of the comments) is noted, and the examiner notes that the use of an extruded profile would be expected to require less processing labor (hence lower cost) compared, for example, to the use of a non-extruded stock element requiring substantial further machining to arrive at the same profile.

Applicant continues, asserting that the references fail to teach a motivation for the combination. The examiner agrees that the references fail to specifically teach a motivation, but also suggests that explicit motivation is not required of the references being combined.

A conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see In re Sovish 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir.

1985)); further, references may be combined although none of them explicitly suggests combining one with the other (see *In re Nilssen* 7 USPQ2d 1500 (Fed. Cir. 1989)). It has long been the law that the motivation to combine need not be found in prior art references, but equally can be found "in the knowledge generally available to one of ordinary skill in the art." *In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (citing *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988)).

The motivation to combine can be found either in a prior art reference, or it can be implicit in the knowledge of one of ordinary skill in the art. See *In re Huston*, 308 F.3d 1267, 1280 (Fed. Cir. 2002); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 (Fed. Cir. 1997).

Sources suggesting a combination may be: (1) the combined teachings of the prior art, (2) the knowledge of the ordinary practitioner and (3) the nature of the problem to be solved. "The test for implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000).

In *Richard Ruiz and Foundation Anchoring Systems, Inc. v. A.B. Chance Company*, No. 03-1333 (Fed. Cir. January 29, 2004), the court emphasized that an "express written teaching in the art" to combine references was not required [emphasis added]. Rather, motivation may come from "the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem."

Please further note the following from Section 2144 of the MPEP: "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent...The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem...It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant." Also Chief Judge Nies writes in a concurring opinion, "While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed



device, it is not necessary that the cited references or the prior art specifically suggest making the combination...In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference". See *In re Oetiker* 977 F.2d 1443, 24 USPQ.2d 1443 (Fed.Cir.1992).

Applicant's assertion that there is no anticipatory reference is noted, and the examiner agrees that there does not appear to be a reference that anticipates applicant's claims. The examiner further notes that a lacking of anticipation is not evidence of non-obviousness, and applicant has provided no further evidence to support the notion. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

As regards applicant's assertion that there is no motivation to combine the references, the examiner disagrees: the motivations for combination are set forth clearly in the statements of rejection.

### **Conclusion**

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hara (US 5,514,018) teaches that it is well known in the art to use a structure associated with a snowboard in the manufacture of a ski or skateboard; Kobylenski et al. (US 5,618,051) teach that an overall snowboard structure may be employed in the making of a skateboard; Augustine et al. (US 5,649,717) teach that materials usable in a snowboard may be likewise used in a ski or skateboard. All three references support the notion that one of ordinary skill in the art would not be limited to skateboard references alone. These references are exemplary only.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry specifically concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 571-272-6701.

Any inquiries of a general nature or relating to the status of this application may be made through either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


A response to this action should be mailed to:

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450,

Or faxed to:

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**F. VANAMAN**  
**Primary Examiner**  
**Art Unit 3618**

  
5/24/06